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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,775	02/15/2001	John Wankmueller	AP33001-070457.0972	2264
21003 7590 11/30/2009 BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498				
EXAMINER				
ONYEZIA, CHUKS N				
ART UNIT		PAPER NUMBER		
3691				
NOTIFICATION DATE		DELIVERY MODE		
11/30/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DLNYDOCKET@BAKERBOTTS.COM

# Office Action Summary

**Application No.**

09/783,775

**Applicant(s)**

WANKMUELLER, JOHN

**Examiner**

CHUKS ONYEZIA

**Art Unit**

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-6, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of Claims***

***Response to Amendment***

1. Acknowledgment is made of applicant's amendments filed on 07/27/2009. It is noted that claim 1 has been canceled, and claims 2-4,ve been amended. Claims 2-6, 8, and 10 are currently pending and have been fully considered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 2-6, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray et al., U.S. Patent No.

7,366,703, in view of Applicant's admitted prior art, and further in view of Chen, U.S. Patent No. 5,590,197.

Claims 2, 3, Gray discloses A method for conducting a payment transaction over a computer network between a consumer and a merchant involving a payment card issued by an issuer institution to the consumer, wherein the computer network includes at least three computers connected thereto, a consumer computer operated by or on behalf of the consumer, a merchant computer operated by or on behalf of the merchant, and a wallet server at a location remote from said consumer that provides functionality for the consumer computer to conduct transactions over the computer network, and wherein the payment card is in a form of either a chip card or a non-chip card, the method comprising: (figure 1), the method comprising:

receiving a request at the remote wallet server from the consumer computer for conducting a payment function with the merchant computer (column 7 lines 7-16);

in response to the request, conducting the payment transaction by the remote wallet server with the merchant computer (column 7 lines 47-50).

Gray fails to teach that the transaction between the wallet server and the merchant computer is in a format compliant with a chip card electronic commerce protocol or specification. Gray fails to define with which type of protocol the transaction is compliant.

According to Applicant's admitted prior art, the EMV '96 Chip Electronic Commerce Specification was known at the time of Applicant's invention. The specification defines a protocol for conducting a transaction between a payment source and a payment receiving system. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Gray to include using a chip card protocol compliant format for conducting the transaction between the wallet and the merchant because security would be an obvious concern when conducting such a transaction, and therefore one of ordinary skill in the art would desire to choose a secure protocol in order to conduct the transaction. It is known that one would desire to use a standardized protocol so as to create a system that can be widely used with any other system supporting the protocol. There are a finite number of known standards in the art for communicating payment or transaction

information. It would have been obvious to choose any known standard for conducting such a transaction.

Gray and Applicant's admission fails to teach generating a cryptogram by the remote wallet server, and sending the payment information and the cryptogram to the merchant.

Chen discloses an electronic payment system and method, wherein a wallet server generates a cryptogram based on a shared secret data object between the remote wallet server and the issuer institution, and sends the payment related information and the cryptogram by the remote wallet server to the merchant computer in response to a request for transaction by the consumer (column 5 lines 42-60). Chen further discloses that the system includes a storage unit having the secret data object stored within, and the means for generating the cryptogram, both of which are stored on a tamper resistant security module (column 3 line 65 - column 4 line 13). It would have been obvious to one of ordinary skill in the art at the time of Applicants invention to modify the teachings of Gray to include the cryptogram methods of Chen because both are related to conducting transactions between a wallet and a merchant, and Chen teaches the benefits of the disclosed payment methods, in

terms of further protecting the account holder from misuse or fraud (column 1 line 56 - column 2 line 7).

Claims 4-6, 8, and 10 are rejected using logic similar to that used in the above rejection of claim 2.

***Response to Arguments***

2. Applicant's arguments filed 07/27/2009 have been fully considered but they are not persuasive.
3. Applicant argues that:
  - a. The Office Action incorrectly assumes that because EMV96 allegedly teaches conducting transactions in a format according to a chip card electronic commerce protocol or specification ("Chip Card Protocol"), that Gray and EMV96 together teach conducting a payment transaction according to a Chip Card Protocol by a wallet server on behalf of a customer.
  - b. Action fails to teach conducting the payment transaction by the remote wallet server with the merchant computer
4. Examiner responds that
  - a. Gray was introduced to disclose teachings of conducting a transaction. Admittedly, Gray fails to define

which type of protocol the transaction uses. Examiner is relying on EMV96 as a well known chip card protocol at the time of invention and the combination of references to disclose Applicant's claimed invention.

b. Gary discloses a security server authorizing the transaction and the wallet server receiving transactional authorization (col 7 lns 44-50) examiner interprets this action as conducting payments

#### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUKS ONYEZIA whose telephone number is (571)270-1372. The examiner can normally be reached on Monday - Thursday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. O./  
Examiner, Art Unit 3691

/Alexander Kalinowski/  
Supervisory Patent

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